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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1950

No. 32

THE GREAT ATLANTIC & PACIFIC TEA COMPANY,
Petitioner,

vs.

SUPERMARKET EQUIPMENT CORPORATION, SUBSTITUTED FOR EVELYN B. BRADLEY AND JOE WEINGARTEN

BRIEF ON BEHALF OF PETITIONER

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BRIEF ON BEHALF OF PETITIONER

This cause comes before this Court on a Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit. The opinion of the United States Circuit Court of Appeals is reported in 179 Fed. (2d) 636 and appears at page 531 of the record. The opinion of the District Court is reported in 78 Fed. Supp. 388 and appears at page 511 of the record. Certiorari was granted on May 1, 1950. The District Court held three claims—claims 4, 5 and 6—of the patent in suit valid and infringed. The Circuit Court of Appeals affirmed by a divided court, Judge Martin dissenting. The petition for rehearing was denied by a divided court, Judge Martin voting to grant the rehearing.

Jurisdiction

The jurisdiction of this Court is invoked under C. 646 of the Act of June 25, 1948, 62 Statute 928, 28 U. S. C. A. 1254.

Statement of the Case

This action originated in the United States District Court for the Eastern District of Michigan, Southern Division, and was based upon alleged infringement by your petitioner, The Great Atlantic & Pacific Tea Company, of the Turnham patent No. 2,242,408 issued on May 20, 1941 and emanating from an application filed October 28, 1938. The original plaintiffs were Evelyn B. Bradley and Joe Weingarten, but the Supermarket Equipment Corporation was substituted for the original plaintiffs (530). The petitioner operates retail food stores throughout the greater part of the United States and is charged with infringing the Turnham patent within the Eastern District of Michigan, which is within the Central Western Division, one of the seven divisions into which the petitioner is divided.

The charge of infringement is based upon the use by the petitioner of a simple three-sided bottomless rack slideable on a checkout counter. The rack used by the petitioner is shown in plaintiff's Exhibit 2 (288) and again in plaintiff's Exhibits 14 and 15 (310-312).

The complaint did not limit the charge of infringement to any specific claim or claims, and the patent in suit contains six claims, all of which petitioner alleges are invalid for lack of invention. At the trial it was stipulated that the claims of the patent in suit if valid would be infringed by petitioner's structure, but there was no stipulation at any time providing for the withdrawal of any of the claims, although respondent withdrew over petitioner's strenuous objection claims 1, 2 and 3. (186).

The Turnham Patent

The Turnham patent No. 2,242,408 (Exhibit 18, p. 318) shows four figures. Fig. 1 is a top plan view of an elongated counter having a top thereon and an extension 6 for a cash register. The place for the checker to stand is indicated at 7. A place is provided at 5 for a bagger. Figure 2 is a side elevation of the counter while Figures 3 and 4 are taken on the lines 3-3 and 4-4 respectively of Figure 1. Turnham provided a "U" shaped rack with a front side bar 26, rear side bar 27 joined by the end bar 28. He provided a channel member 30 which was anchored to the counter and which cooperated with an inner fitting channel member 31 affixed to the side bar 27 by bolts or screws 32, thus preventing the framework 20 from being elevated beyond the side of the channel 30. In order to guide the frame in its sliding movement the side bar 26 was provided with a base 35 which fits into a channel 36 affixed on the edge 37 of the counter 15. This is a much more complicated device than petitioner's device, shown in Exhibit 13 and the photographs of the device used by the petitioner, Exhibits 14 and 15. It was this complicated device which was before the Patent Office. Exhibit 13 does not show the Turnham structure as originally designed nor as in use today (56-57).

It will be noted that although the Turnham application was filed on October 28, 1938, approximately a year and four months after the merchandise handlers designed by Turnham are claimed to have been put into operation in the Weingarten stores, no mention is made in the patent of the segregation of the merchandise into groups such as vegetables, canned goods, meats and groceries, which was used in the petitioner's presorter (288), nor was the Turnham device designed for operation by the checker. There was no operating handle such as shown in E of Plaintiff's Exhibit 25 (374). The patent contemplated a pusher-boy to

load the groceries from the customers' baskets onto the rack on the extension of the counter and to push them up to the cashier when needed. It is believed that the lower Court in its opinion misinterpreted the language of the patent specification. At (512) the Court referred to the patent (at page 2, column 1, line 35) as disclosing a handle for the checker when said handle was clearly for the pusher. The Turnham patent appears at pages 318, et seq. of the record. Page 2, column 1, lines 25-35 describes a handle 24 "which may be grasped by the pusher-boy in order to move" the rack, or the frame may be grasped directly. This obviously refers to the action of a pusher-boy. The Turnham device as now used is substantially the same as that shown in the patent embodying channels 30 and 36 but has been modified to include a weight to automatically return the pusher to the extension of the counter and roller bearing wheels to make it run easily (57), and a handle has been added for operation by the checker.

History of the Super Market

The super market, as such, is a relatively new development. It is true that for some time there have existed self-service stores, i.e. stores wherein the customer waits upon himself and then pays at the exit. One Clarence Saunders opened the Piggly-Wiggly Stores in 1917 or 1918 (84) and Weingarten opened his first store in 1919 (84). Other small developments, such as the A B C Stores (46) sprung up from time to time. In the early days, the customer would use a wicker or splint basket and carry it around the store picking up merchandise and would eventually check out through a straight counter. About 1927 an extension was made to the counters to accommodate the cash register (47). Apparently there were not many changes in the industry until after 1935. At about that

time the Kroger Grocery and Baking Company opened up self-service stores and many of the so-called "super markets" were opened up. The term "super market" apparently originated on Long Island in the late 30's and was defined by the witness, Bucher, as "a market that does a large volume of business at the minimum cost to the customer and maximum operating efficiency" (39).

The industry has continuously changed its equipment to give more efficient service.

By 1937 the Super Market Institute was organized among the smaller chains and information exchanged (95). At (95) Mr. Weingarten was asked by the Court—"Does A. & P. and Kroger belong to that?" Answer—"No, sir. We don't allow them to."

The larger chains operated on a greater volume at a smaller profit. In 1937 or thereabouts the plaintiff, Weingarten, joined in a price war with petitioner, The Great Atlantic & Pacific Tea Company (94 & 78-79). In waging this price war Weingarten cut his gross profits by 4% to 6% and thereby increased his sales some 25% (79).

This increase in sales presented a problem in handling the flow of customers from the stores. In 1937 Adolph Sobotik, the manager of the Weingarten Store No. 7, found that his four check-out counters were crowded and requested additional check-out counters. Around June of 1937 Weingarten called up Mr. Turnham and ordered him to "Give Adolph some relief over there." Sobotik testified:

> "Q. Did you run into any problems from the standpoint of handling your customers during that period? A. Yes, I have. In 1937, about the first quarter of the year, my business was on the upgrade and I only had four checking counters in that grocery department. I had difficulty taking care of my customers and checking them out, especially on Saturdays in the peak hours. I asked Mr. Turnham, who was our supervisor, to get me additional checking counters, that I can not

take care of my business with the present equipment I have. He kind of put me off a few days, and I went up to Mr. Joe Weingarten. Then Mr. Joe Weingarten got together with Mr. Turnham, they come back to look the situation over, and Mr. Turnham said he has an idea that he can relieve the situation on the present checking counters, to give him a few more days. And that happened just about the first part of July, 1937. Then about the middle of July, 1937, Mr. Turnham came out there with one of the carpenters and put a slide similar like I saw in the Exhibit No 13, with a little counter on the end" (77).

This apparently did not solve the problem since increased business necessitated additional check-out counters. On cross-examination the witness Sabotik was asked:

"Q. Mr. Sabotik, you testified, I believe, that originally in 1937 there were four check-out counters in that No. 7 store? A. Yes, sir.

Q. How many are there today? A. Today there are seven.

Q. Seven. You found it necessary to increase the number of check-out counters? A. Yes. The business is about one hundred per cent more than it was then, today."

Joseph Weingarten testified that there were eight counters at the time of the trial in the No. 7 store (96). It is passing strange that despite the alleged efficiency of Turnham's device the number of check-out counters increased almost in direct proportion to the increase in business.

At the trial petitioner introduced into evidence four patents cited by the Patent Office during the prosecution of the Turnham application and some seventeen patents not cited by the Patent Office. The prior art shows various means for moving objects from one place to another and the more pertinent patents will be discussed later.

The patent contains six claims, three of which—1, 2 and

3--were withdrawn from the action over the defendant's objection. At the trial it was conceded that the claims in suit would be infringed if the patent were valid. The patent in suit appears in the record at page 319, and a photograph of the alleged infringing device at page 288A. Claims 4, 5 and 6 read as follows:

"4. A checker's stand including a counter of the character described, an open bottom pusher frame thereon, means to guide said frame in sliding movement so that goods placed on the end of said counter within said frame may be pushed along the counter in a group to a position adjacent the checker by movement of said frame.

"5. A cashier's counter for cash and carry type of grocery comprising a portion spaced from the cashier's stand and upon which the merchandise may be deposited and arranged, a bottomless three sided frame on said portion and within which the merchandise is deposited and arranged, means whereby said frame is movable on said counter from said portion to a position adjacent the cashier's stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier.

"6. A cashier's counter for cash and carry type of grocery comprising a portion spaced from the cashier's stand and upon which the merchandise may be deposited and arranged, a bottomless frame on said portion and within which the merchandise is deposited and arranged, means whereby said frame is movable on said counter from said portion to a position adjacent the cashier's stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier, said frame being open at the end adjacent the cashier's stand and readily movable to be returned over said portion so as to receive the merchandise

of another customer while the cashier is occupied with the previous group."

The District Court in its opinion (page 515) stated:

"The bottomless tray is not novel, as note, for example, the well known pool rack. Neither is a checking-out counter nor the use of guide rails. These have been seen in self-serve restaurants for years. However, the extension of the checking-out counter was apparently something new, as it automatically placed the register farther up on the checking-out aisle, and the use of the bottomless tray on that extension, self-unloading its contents right in front of the cashier, was decidedly a novel feature."

The majority opinion of the Circuit Court of Appeals quoted with approval the District Court finding 15 (533-4):

"'15. Claims 4, 5 and 6 of the patent in suit define a new combination of elements brought together for the first time by Turnham to provide an improved checkout counter.

"'Three-sided bottomless racks or trays had been used in racking pool balls prior to the Turnham invention. Also checking-out counters were known. Moreover, guide rails for trays had been used in self-serve restaurants.

"'However, the conception of a counter with an extension to receive a bottomless self-unloading tray with which to push the contents of the tray in front of the cashier was a decidedly novel feature and constitutes a new and useful combination.'"

The District Court allowed the respondent to withdraw over petitioner's objection claims 1, 2 and 3 and the Circuit Court of Appeals held in the majority opinion that the District Court did not err in refusing to pass on the validity of these claims.

Specification of Errors Urged

The Circuit Court of Appeals erred:

1. In adopting as an element of the claims in suit the extension to the checkout counter which was not an element of the claims in order to find a novel combination.

2. In finding that the adaptation of a three-sided bottomless rack, old in the art, to a checkout counter constituted invention over the prior art.

3. In affirming the District Court's action in allowing plaintiff to withdraw his broader claims—claims 1, 2 and 3—from suit and refusing to pass on the validity thereof.

4. In not holding that the Turnham contribution was a mere expedient not rising to the dignity of invention.

5. In affirming by a divided court the decision of the District Court.

Summary of Argument

1. The courts below based the finding of invention on a combination of elements not set forth in the claims in suit.

2. The Turnham patent in suit does not involve invention over the prior art, but is merely the expedient of a skilled mechanic.

3. It was error to allow the plaintiff to withdraw the broadest claims from the suit.

Argument

1. *The courts below based the finding of invention on a combination of elements not set forth in the claims in suit.*

The District Court and the majority opinion of the Circuit Court of Appeals found that novelty and invention reside in a combination of three elements: 1) a checkout counter; 2) an extension on the checkout counter; 3) a three-sided rack.

This is obvious from the District Court's opinion (R.P. 515) wherein Judge Picard stated:

> "The bottomless tray is not novel, as note, for example, the well known pool rack. Neither is a checking-out counter nor the use of guide rails. These have been seen in self-serve restaurants for years. However, the extension of the checking-out counter was apparently something new, as it automatically placed the register farther up on the checking-out aisle, and the use of the bottomless tray on that extension, self-unloading its contents right in front of the cashier, was decidedly a novel feature."

The majority opinion (R. 524) quoted with approval finding 15:

> " '15. Claims 4, 5 and 6 of the patent in suit define a new combination of elements brought together for the first time by Turnham to provide an improved check-out counter.
>
> " 'Three-sided bottomless racks or trays had been used in racking pool balls prior to the Turnham invention. Also checking-out counters were known. Moreover, guide rails for trays had been used in self-serve restaurants.
>
> " 'However, the conception of a counter with an extension to receive a bottomless self-unloading tray with which to push the contents of the tray in front of the cashier was a decidedly novel feature and constitutes a new and useful combination.' "

An examination of the claims in suit makes it clear that the extension was not set forth nor claimed. Claim 4, for instance, reads as follows:

> "4. A checker's stand including a counter of the character described, an open bottom pusher frame thereon, means to guide said frame in sliding movement so that goods placed on the end of said counter within said frame may be pushed along the counter

in a group to a position adjacent the checker by movement of said frame."

The only structure specifically defined in said claim is "A checker's stand including a counter", which is admittedly old, and "an open bottom pusher frame". These elements the courts found to be old. They did, however, base the finding of invention on the combination of these elements with an extension on the checkout counter. Circuit Judge Martin recognized that the extension of the counter was not claimed in claims 4, 5 and 6, and in his dissenting opinion stated:

> "I am unable to find invention in the patent claims in suit. It seems to me that the combination of the admittedly old elements as described in the claims does not rise to the dignity of invention, and that the findings of fact of the district court are clearly erroneous."

It is well settled law that every element and limitation relied upon to establish the validity of a claim must be particularly pointed out and distinctly claimed.

Walker on Patents (p. 770) summarizes the function of a patent claim as follows:

> "It is the claims of a patent which 'measure the invention,' and which 'apprise the public of what is still left open to them.' (Paper Bag Pt. Case, 210 U. S. 405, 409; U. S. L. & H. Corp. v. Safety Car H. & L. Co., 261 Fed. 915, 918, C. C. A. 2; Fulton Co. v. Powers Reg. Co., 263 Fed. 578, 580, C. C. A. 2; Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U. S. 502, 61 L. Ed. 871, 876). A claim is not 'like a nose of wax which may be turned and twisted in any direction,' so as to make it include something more than, or something different from, what its words express, by merely referring to the specification. The claims are the creature of statute in which the inventor is required to particularly point out and distinctly claim his invention. (White v. Dunbar, 119 U. S. 47, 51.)"

As long ago as 1895 this Court held that an element may not be read into a claim for the purpose of sustaining a patent. In *McCarty* v. *Railroad Co.* (160 U.S. 110, 116, 40 L. Ed. 358, 361), Mr. Justice Brown writing for this Court stated:

> "There is no suggestion in either of these claims that the ends of the bolster rests upon springs in the side trusses, although they are described in the specification and exhibited in the drawings. It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim, and avoid a defense of anticipation, we should never know where to stop. If, for example, a prior device were produced exhibiting the combination of these claims plus the springs, the patentee might insist upon reading some other element into the claims, such, for instance, as the side frames and all the other operative portions of the mechanism constituting the car truck to prove that the prior device was not an anticipation. It might also require us to read into the fourth claim the flanges and pillars described in the third. This doctrine is too obviously untenable to require argument."

The foregoing case has been cited with approval consistently through the year, and more recently the same principle was set forth in the case of *Altoona Publix Theatres, Inc.*, v. *American Tri-Ergon Corporation* (294 U. S. 477, 79 L. Ed. 1005). There the Court stated, at page 487:

"The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photoelectric cell, the arcuate flexing of the film, the flywheel, the flexible connection of the flywheel and the optical slit, although no where in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute it is the claims of the patent which define the invention. See White v. Dunbar, 119 U. S. 47, 51, 52, 30 L. Ed. 303, 304, 305, 7 S. Ct. 72; McClain v. Ortmayer, 141 U. S. 419, 423-425, 35 L. Ed. 800, 802, 803, 12 S. Ct. 76; Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 419, 52 L. Ed. 1122, 1128, 28 S. Ct. 748; Smith v. Snow, decided January 7, 1935 (294 U. S. 1, ante, 721, 55 S. Ct. 279). And each claim must stand or fall, as itself sufficiently defining invention, independently of the others. See Carlton v. Bokee, 17 Wall., 463, 472, 21 L. Ed. 517, 519; Russell v. Place, 94 U. S. 606, 609, 24 L. Ed. 214, 215; Leeds & C. Co. v. Victor Talking Mach. Co., 213, U. S. 301, 319, 53 L. Ed. 805, 813, 29 S. Ct. 495; T. H. Symington Co. v. National Malleable Castings Co., 250 U. S. 383, 385, 63 L. Ed. 1045, 1048, 39 S. Ct. 542; Smith v. Snow (294 U. S. 1, ante, 721, 55 S. Ct. 279), supra; Walker, Patents, 6th ed. § 220. As none of the flywheel claims as drawn define an invention, none can be aided by reading into it parts of the specifications, or of other claims, which the patentees failed to include in it."

The foregoing case also stands for the proposition that where the Court of Appeals does not pass on the separate claims in issue but finds invention in a combination of elements not embraced in any single claim, the case presents no question of concurrent findings by the courts below that the claims in issue involved invention.

It is submitted that the dissenting opinion below is ob-

viously correct in finding a lack of invention in the claims in suit.

Revised Statute 4888 requires that the inventor point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery. This statute was recently construed in the case of *Halliburton Oil Well Cementing Co.* v. *Cranford P. Walker* (91 L. Ed. 15; 329 U. S. 1). There the Court held that the claims of the Walker patent in suit were invalid, because they described the crucial element in terms of what it would do rather than in terms of its own physical characteristics or its arrangement in the new combination.

Claim 1 of the Turnham patent quite obviously described what is alleged to be new by its function and merely defines "an open bottom enclosure movable relatively to the extension and counter to slide the merchandise along the said top and extension to a position on said counter."

Claim 2 merely calls for "means slidable on the surface of the counter to enclose and move such merchandise to the cashier station."

Claim 3 merely call for "means to enclose such merchandise on the surface of the counter and to move with such merchandise to the cashier station, so that all the articles of merchandise of a customer will be postitioned together."

Claim 4 calls for an open bottom pusher frame thereon and "means to guide said frame in sliding movement so that goods placed on the end of said counter within said frame may be pushed along the counter in a group to a position adjacent the checker." The means there to guide the frame are the channel members 30 and 36 shown in the drawings and they are not particularly pointed out nor distinctly claimed.

Claim 5 calls for a bottomless three-sided frame within

which the merchandise is deposited and arranged, and "means whereby said frame is movable on said counter."

Claim 6 is even more vague and indefinite. It refers merely to a portion to receive the groceries, a bottomless frame and "means whereby said frame is movable on said counter from said portion to a position adjacent the cashier stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier." The means whereby said frame is movable are the channels 30 and 36 and these are not distinctly claimed as required by the statute. If they were properly claimed and described defendant's structure would not infringe. *The stipulation as to infringement referred to the claims as drawn, not as they should have been drawn.*

It is obvious from reading the claims that all of the claims attempt to define the structure in "terms of what it will do rather than in terms of its own physical characteristics" and are, therefore, invalid. (*Halliburton* v. *Walker*, *supra*.)

2. *The Turnham patent in suit does not involve invention.*

It is submitted that the dissenting opinion below is obviously correct in finding a lack of invention in the claims in suit. Even a cursory examination shows that it was common in the art to supply racks, pushers and similar devices wherever they were needed. Even the patents cited by the Patent Office teach this. (The Storch patent (405), for instance, shows a device for moving packages from outside a building through the wall thereof without the person delivering gaining entrance to the building. Harvey, page 416, shows a store counter with a track and a small truck mounted on the track to be used in re-stocking the shelves. More pertinent patents are contained in Exhibit F. These patents,

reproduced at page 421, *et seq.*, were not cited by the Patent Office during the prosecution of the application and their pertinence is overlooked by the court below. Marois, page 423, shows a rack slidable on a cashier's counter with means to protect the cashier. One of the most pertinent patents is the patent to Varnum, at page 427, which shows a three-sided bottomless rack for stacking pool balls. The majority opinion below stated at page 536 that this rack was not self-unloading, but it is as much self-unloading as the Turnham rack which must be pushed or pulled back after it has been used to move the merchandise up to the cashier. The language of the Varnum specification starting at line 108 on page 428 makes this obvious. Varnum reads as follows:

> "In using the pool ball rack of my invention, it is manipulated by grasping the handles 21 and 22 and separating the sides 7 and 8 against the action of the springs 12 and 13. The rack may then be used as a scoop, by sliding it over the surface of the pool table to gather in the balls 26. When all fifteen balls have thus been gathered in, the sides 7 and 8 should be permitted to turn upon their hinges 12 and 13 toward each other, urging the balls 26 together and collecting them in the form of a triangle or pyramid, in accordance with the rules of the game. The collected balls 26 and frame are then moved across the table to position them properly for the start of the game, after which the sides 7 and 8 may be separated to permit removal of the frame without disturbing the accurate arrangement of the balls 26."

The Dickinson patent, page 430, particularly Figure 4, shows a similar rack with a runway to receive the balls. This runway terminates in a rack which, as is shown in Figure 4, may be opened so as to be self-unloading when it is moved to the rear.

Respondent would dismiss the Varnum and Dickinson disclosures on the ground that they are not used in connection with a grocery counter.

It is well settled that new use of an old object or the slight modification of an old object, does not constitute invention. (*Peters* v. *Active Mfg. Co.*, 129 U. S. 530 (1889); *Peters* v. *Hanson*, 129 U. S. 541 (1889); *St. Germain* v. *Brunswick*, 135 U. S. 227, 230, 34 L. Ed. 122, 123 (1890); *Patent Clothing Co.* v. *Glover*, 141 U. S. 563 (1891); *Ansonia Co.* v. *Electrical Supply Co.*, 144 U. S. 11 (1892); *Neptune Meter Co.* v. *National Meter Co.*, 127 Fed. 563 (1904); *Morton Trust Co.* v. *American Car & Foundry Co.*, 169 Fed. 109 (1909); *Lewis Construction Co.* v. *Semple*, 177 Fed. 407, 410 (1910), cert. den. 218 U. S. 679, 54 L. Ed. 1207.)

The patent to Arnold (page 433) shows a grocery store appliance which has a rack or a tray shown in Figure 7 which is designed to move merchandise out where the customer can reach it. As the customer takes the outside device off the shelf, the rack moves another in place.

The Rorrer patent (page 439) shows rails or tracks to guide a tray or other container to be slid over the counter.

The Greenberg patent (page 451) shows a tray to be slid along a counter and means to guide it against lateral movement.

The Anderson patent (page 455) shows a store in which a roller track is provided so that trays carrying merchandise may be easily pushed around from spot to spot.

The other patents constituting Exhibit F all show various means for moving merchandise from one point to another. Morsa (page 482) shows a U-shaped rack for moving cans in and out of a boiling device. The Court recognized that the use of U-shaped bottomless frames for moving merchandise was not new (515 & 524).

Even the chart prepared by respondents' witness, Lester B. Clark, Exhibit 26 (page 376) shows the various elements

alleged to be claimed by the Turnham patent are not new, each of the eight elements—except the alleged extension to the check-out counter—appearing in the art cited.

When a check-out counter is extended or when it is long enough to start with is, of course, a matter of opinion and degree. We differ with Mr. Clark in that we find that both Varnum and Dickinson are self-unloading to the extent that they leave the pool balls in place when they are opened and pulled back. By the same token, they deposit the articles, convey them and unload on the same surface. It will be noted that most of these items are found in the art not cited by the Patent Office. Mr. Clark did not find that Varnum had operating handles but certainly the elements 21 and 22 cannot be otherwise designated and it will be remembered that the only operating handle shown in the Turnham patent, Exhibit 18, is the member 24 which cannot be operated by the checker but only by a pusher boy. Certainly if the prior art did not directly anticipate the Turnham patent it teaches enough so that it did not amount to invention to apply it to its present use. (*Enterprise Railway Equipment Co.* v. *Pullman Standard Car Mfg. Co.*, 95 F. (2) 17, 21.) Turnham's development certainly does not meet the test of invention laid down by this Court. *Cuno Engineering Corporation* v. *Automatic Devices Corporation* (314 U. S. 84, 80 L. Ed. 58).

3. *It was error to allow the plaintiff to withdraw the broadest claims from the suit.*

The complaint as filed (P. 1) alleged infringement of the Turnham patent No. 2,242,408 without restriction as to the claims involved. During the trial plaintiff, over defendant's objection, withdrew claims 1, 2 and 3, but has filed no disclaimer of these claims (186). Your petitioner at no time acquieseed in the limitation of this action to claims 4, 5 and 6, but, on the contrary, vigorously opposed the

withdrawal of these claims (186) and pointed out to the court that it never consented to the withdrawal of claims 1, 2 and 3. It is your petitioner's contention that the claims having been placed in litigation by the patent owner and their validity having been challenged, the lower court should not have allowed the plaintiff-respondent to withdraw these claims from issue without disclaiming them.

Claims 1, 2 and 3 are obviously broader than claims 4, 5 and 6 and it is interesting to note that claim 1 is the only claim to specifically set forth and distinctly claim the extension to the check-out counter, the element upon which the lower courts relied to spell out invention. Claim 2 reads as follows:

> "A cashier's counter in a cash and carry type of grocery, a cashier station, a portion on the counter to receive the merchandise being purchased, and means slidable on the surface of the counter to enclose and move such merchandise to the cashier station."

The language of this claim is so broad that it would be anticipated by any number of the prior art patents and would be infringed by sliding a basket along the surface of the counter. The language "means slidable on the surface of the counter to enclose and move such merchandise to the cashier station" clearly justifies such an interpretation.

That claims 1, 2 and 3 were broader than claims 4, 5 and 6 is admitted by the respondent and was never seriously questioned. It is conceded that if the respondent had withdrawn these claims on the theory that they were not infringed, they might have been within their rights, but such withdrawal would have been with prejudice. Nowhere is there any intimation that the respondent considered claims 1, 2 and 3 not infringed. On the contrary, in their brief before this court in opposition to the petition for writ of certiorari Point 3 of respondent's argument

is entitled "Respondent's Reliance on the Three Narrower Claims of the Patent and the Refusal of the Two Lower Courts to Pass on the Validity of the Broader Claims is not at variance with the Statutes or with the Decisions of this Court".

It is submitted that where a claim is challenged as to its validity the patentee is under a duty either to disclaim the claim or, where he has the opportunity, to litigate. The patentee had the opportunity here to litigate but rejected the opportunity and neglected to disclaim. The law is clear that where a claim is held invalid it must be either disclaimed or be relitigated promptly. *Ensten* v. *Simon Ascher & Co.* (282 U. S. 445, 75 L. Ed. 453). In the present suit had the court held claims 4, 5 and 6 invalid, the patentee would have been in a position to bring a new action against another defendant under claims 1, 2 and 3. Defendant had a right to an adjudication of claims 1, 2 and 3 since, if they should have been disclaimed, the failure to so disclaim would affect the question of costs (R. S. 4922, 35 U. S. C. 71).

Both of the lower courts dismissed petitioner's argument and in so doing relied on the case of *Ford Motor Co.* v. *Gordon Form Lathe Co.*, (90 F. 2d 999, CCA 6). (See the Record, Pg. 521-536.) This case, however, does not support the position of respondent nor of the courts below, as will be apparent from a reading of the short Per Curiam opinion in that case. It is very clear from a reading of the opinion that the claims involved in that case were withdrawn from the consideration of the court and that "defendant acquiesced in this proceedure". Quite obviously if the parties agree to the withdrawal of an issue before the court it may be withdrawn, but where one party strenuously objects to the withdrawal of an issue initiated by his opponent, it is error not to adjudicate the issue.

The law on this point is well stated in a recent opinion by

Judge Sweeney sitting in the District Court in Massachusetts in the case of *Kendall Co.* v. *Tetley Tea Co., Inc.* (81 F. Supp. 387, 388). In that case the complaint did not specify any specific claims as infringed, but in response to interrogatories the plaintiff charged that claims 1, 2 and 3 were infringed. Thereafter, and before trial, they attempted to add additional claims and to eliminate claims 1 to 3 from the consideration of the court. The defendant agreed to the inclusion of the additional claims but objected to the elimination of claims 1 to 3. The court wrote:

> "To allow such an amendment, when issue has been joined for such a long period of time, would be an injustice to the defendant. Furthermore, the more recent trend of decisions indicates the public interest in any adjudication of the issues of infringement and validity of patent claims, particularly the issue of validity, and for that reason, as well, the motion must be denied. (See Edward Katzinger Co. *v.* Chicago Metallic Manufacturing Co., 329 U. S. 394, 67 S. Ct. 416, 424, 91 L. Ed. 374; Sinclair & Canol Co., Inc. *v.* Interchemical Corporation, 325 U. S. 327, 65 S. Ct. 1143, 89 L. Ed. 1644; Lackner Co., Inc., et al. *v.* Quehl Sign Co., 6 Cir., 145 F. 2d 932; Trico Products Corporation *v.* Anderson Co., 7 Cir. 147 F. 2d 721; F. E. Myers & Bros. Co. *v.* Goulds Pumps Inc., D. C., 7 F. R. D. 416; Phillips Petroleum Co. *v.* Shell Development Co., D. C. 6 F. R. D. 406.) It is immaterial that the issues as to claims 1 and 3 have been joined by defendant's answer rather than by counterclaim or demand for declaratory judgment. Addition of claims 5, 12 and 14 is allowed; withdrawal of 1 and 3 is denied."

It is the position of your petitioner that once a patent has been put into litigation and the validity of the claims thereof have been challenged, the patentee is under a duty to either litigate the claims or disclaim them. The effect of the lower court's ruling to the contrary would be to allow the holder

of an obviously invalid patent to harass industry by bringing repeated actions and then withdrawing all but a single claim of his patent. The number of actions would only be limited by the number of claims in the patent.

It is submitted that the courts below should have adjudicated the entire patent and not allowed the patentee to withdraw, obviously invalid claims without disclaiming them.

The Myth of Commercial Success

Much ado has been made below about the alleged commercial success of the Turnham device. It is petitioner's position that (1) there was no commercial success, and (2) that no amount of commercial success could raise Turnham's contribution to the dignity of invention. Up until the time of trial in April of 1947 only one small chain of four stores, located in Jackson, Michigan, had taken a license under the Turnham patent and that license (Plaintiff's Exhibit 17) was issued two months before the trial, and almost ten years after the installation in the Weingarten stores of the Turnham device. As recently as January 3, 1949 this court considered the doctrine of commercial success and in the case of *Jungersen* v. *Ostby & Barton Co.* (80 U. S. P. Q. 32; 335 U. S. 560; 93 L. Ed. 232) stated:

> "Numerous licenses under the patent were issued in the United States and other countries. The fact that this process has enjoyed considerable commercial success, however, does not render the patent valid. It is true that in cases where the question of patentable invention is a close one, such success has weight in tipping the scales of judgment toward patentability. Goodyear Tire & Rubber Co. *v.* Ray-O-Vac Co., 321 U. S. 275, 279 (60 USPQ 386, 388), and cases cited in footnote 5 thereof. Where, as here, however, invention is plainly lacking, commercial success cannot fill the void. Dow Chemical Co. *v.* Halliburton Co., 324 U. S. 320, 330 (64 USPQ 412, 416); Toledo Pressed Steel Co. *v.* Standard

Parts, Inc., 307 U. S. 350, 356-7 (41 USPQ 593, 595); Textile Machine Works *v.* Hirsch Co., 302 U. S. 490, 498-99 (36 USPQ 37, 40); 1 Walker, Patents (Deller, 1937) § 44. Little profit would come from detailed examination of the cases cited above or those indicated by reference. Commercial success is really a make-weight where the patentability question is close.

"Increased popular demand for jewelry or alertness in exploitation of the process may well have played an important part in the wide use of the patent. We cannot attribute Jungersen's success solely or even largely to the novelty of his process.

"We hold all the claims of the patent invalid for want of invention."

Conclusion

It is submitted that the courts below have erred:

1. In reading into claims 4, 5, and 6 the extension to the check-out counter which was not an element of the claims in order to find a novel combination.

2. In finding that the adaptation of a three-sided bottomless rack, old in the art, to a check-out counter constituted invention over the prior art.

3. In affirming the District Court's action in allowing plaintiff to withdraw his broader claims—claims 1, 2 and 3—from suit and refusing to pass on the validity thereof.

4. In not holding that the Turnham contribution was a mere expedient not rising to the dignity of invention.

It follows that the judgment of the Circuit Court of Appeals and of the District Court should be reversed and the cause remanded for dismissal of the complaint.

Respectfully submitted,

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